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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,883	04/17/2004	Jean Qiu	NXL-001	8609
32836	7590	03/08/2006	EXAMINER	
GUERIN & RODRIGUEZ, LLP 5 MOUNT ROYAL AVENUE MOUNT ROYAL OFFICE PARK MARLBOROUGH, MA 01752			BEISNER, WILLIAM H	
		ART UNIT		PAPER NUMBER
		1744		

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/825,883	QIU, JEAN	
	<b>Examiner</b>	<b>Art Unit</b>	
	William H. Beisner	1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 December 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9, 14-19, 21 and 22 is/are pending in the application.
  - 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 14-19, 21 and 22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 April 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/5/05; 12/16/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group III, Claims 14-20, in the reply filed on 12/08/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
  
2. Claims 1-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/8/05.

### ***Information Disclosure Statement***

3. The information disclosure statements filed 12/5/05 and 12/16/05 have been considered and made of record.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
  
5. Claims 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 is indefinite because it is not clear how the recited “plastic substrate” differs from the previously recited “supporting component” if at all. The claim will be examined on its merits as though the supporting component of claim 14 is a plastic substrate.

In claim 16, “said supporting components” lacks antecedent basis. Note claim 14 only recites “a supporting component”. Claims 17 and 18 are indefinite because they depend from indefinite claim 16.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 14, 16, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Weiner (DE 19952139).

With respect to claim 14, the reference of Weiner discloses a device that includes a micropatterned embedded plastic film (7) having a plurality of regions formed by contrast features (8) each region has a unique identifier (See Figure 4). The device also includes a supporting component (3) bonded to the film wherein the support and film define a volume for holding a liquid and wherein the contrast features are observable under a microscope.

With respect to claim 16, the film (7) and supporting component (3) are bonded with an adhesive (See the English language abstract).

With respect to claims 21 and 22, whether the grid is molded, etched or printed on the film, the features would result in the existence of both raised and recessed elements when forming the grid pattern on the film surface.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner (DE 19952139) in view of Lorinez (US 5,812,312).

The reference of Weiner has been discussed above.

Claim 15 differs by reciting that the supporting element is a plastic substrate.

The reference of Lorinez discloses that the use of plastic slides rather than glass slides is known in the art because glass is prone to breakage (See column 3, lines 54-65).

In view of this teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a plastic rather than glass slide for the known and expected result of providing an alternative means recognized in the art to achieve the same result, provide a supporting component for optically observing a specimen under a microscope.

11. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner (DE 19952139) in view of Barbera-Guillem et al.(US 2002/0072113).

The reference of Weiner has been discussed above.

With respect to claims 17 and 18, while the reference of Weiner discloses the use of an adhesive, the reference is silent as to the specific type of adhesive employed.

The reference of Barbera-Guillem et al. discloses that the use of a variety of adhesives is known in the art when attaching a film to a substrate within an optical observation device (See paragraph [0029] and [0031]).

In view of this teaching, in the absence of a showing of criticality and/or unexpected results, it would have been obvious to one of ordinary skill in the art to determine the optimum adhesive to employ based on design considerations such as the intended use and/or specific materials of construction while maintaining the efficiency of the device.

12. Claims 15, 19, 21 and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner (DE 19952139) in view of Mitchell (US 4,997,266).

The reference of Weiner has been discussed above.

Claim 15 differs by reciting that the supporting element is a plastic substrate.

The reference of Mitchell discloses that the use of plastic slides rather than glass slides is known in the art (See column 1, lines 52-62).

In view of this teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a plastic rather than glass slide for the known and expected result of providing an alternative means recognized in the art to achieve the same result, provide a supporting component for optically observing a specimen under a microscope.

Claim 19 differs by reciting that the device includes a plurality of wells.

The reference of Mitchell discloses that it is conventional in the art to provide a plurality of wells (16) on an optical observation device.

In view of this teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of the primary reference with a plurality of wells as is conventional in the art for optically observing a plurality of samples on a single substrate device.

With respect to claims 21 and 22, if the reference of Weiner does not inherently discloses raised and recessed features, the reference of Mitchell discloses that it is conventional in the art to micromold grid features on a plastic material (See column 1, line 52, to column 2, line 13).

In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide the grid pattern of the primary reference using the grid manufacturing process disclosed by the reference of Mitchell for the known and expected results of employing an alternative means recognized in the art for providing the required grid pattern of the primary reference.

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13. Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner (DE 19952139) in view of Iwaki Glass (JP 2001/017157).

The reference of Weiner has been discussed above.

Claim 19 differs by reciting that the device includes a plurality of wells.

The reference of Iwaki Glass discloses that it is conventional in the art to provide a plurality of wells (24) on an optical observation device.

In view of this teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of the primary reference with a plurality of wells as is conventional in the art for optically observing a plurality of samples on a single substrate device.

14. Claims 21 and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner (DE 19952139) in view of Uchida et al.(JP 11/075819).

The reference of Weiner has been discussed above.

With respect to claims 21 and 22, if the reference of Weiner does not inherently discloses raised and recessed features, the reference of Uchida et al. discloses that it is known in the art to form a grid pattern in a optical observation device using fine wire (See the English language abstract).

In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide the grid pattern of the primary reference using the grid manufacturing process disclosed by the reference of Uchida et al. for the known and expected results of employing an alternative means recognized in the art for providing the required grid pattern of the primary reference.

***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Beisner whose telephone number is 571-272-1269.

The examiner can normally be reached on Tues. to Fri. and alt. Mon. from 6:15am to 3:45pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys J. Corcoran can be reached on 571-272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William H. Beisner  
Primary Examiner  
Art Unit 1744

WHB